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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/001,878	11/19/2001	Rasean L. Hamilton	ACSC 60015 (1906D)	3409

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EXAMINER
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THANH, LOAN H

ART UNIT	PAPER NUMBER
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3763

DATE MAILED: 06/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/001,878

Applicant(s)

HAMILTON ET AL.

Examiner.

LoAn H. Thanh

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 20-25 is/are pending in the application.
- 4a) Of the above claim(s) 20 and 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 03/15/04.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

The priority claim of the application is temporarily withdrawn. And it is noted that applicant wishes to claim the application as a continuation and not as a CIP. In view of the amendments made, the priority of the application raises new issues which make it unclear. Applicant is requested to confirm the priority or contact the Examiner prior to the time of issue to make the record clear.

The drawing objection has been withdrawn in view of applicant's arguments filed 03/15/04.

The specification objection has been withdrawn in view of applicant's arguments filed 03/15/04.

The double patenting rejection has been withdrawn in view of applicant's remarks.

### ***Information Disclosure Statement***

The information disclosure statement filed 03/15/04 has been considered.

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### ***Drawings***

The proposed drawing of fig. 8 has not been approved. The drawing is not the originally elected embodiment.

### ***Specification***

The amendment filed 03/15/04 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The claims are supported by the proposed fig. 8 , however, new fig. 8 has not been approved because it introduces new matter. As well, claim 24 is considered to be directed to proposed figure 8 which is not approved.

Applicant is required to cancel the new matter ( new fig. 8) in the reply to this Office Action.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 22-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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In claim 22, Applicant has claimed the sheath to be secured to the tip member which is enabled. However, applicant has claimed "or the elongated catheter shaft" in the last line of the claim. How is the tip member "secured to the balloon catheter" if the sheath is secured to the elongated catheter shaft. It appears that applicant is attempting to claim too broad and the claim becomes vague and unclear regarding the tip is distally apart from the distal end and secured.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 22-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Atkinson et al. ( U.S. Patent No. 5,256,145).

Atkinson et al. disclose a balloon catheter 80 having a balloon 82 on the distal shaft section of the balloon catheter 8, a tip member 88 secured to the distal end of the balloon catheter and spaced distally apart from the elongated catheter shaft. Atkinson et al. shows a sheath 98 which is disposed about the tip of the member or the elongated catheter shaft.

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***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Atkinson et al. (U.S. Patent No. 5,256,145) in view of Burns et al. (U.S. Patent No. 5,176,698).

Atkinson et al. Disclose the invention as substantially claimed. However, Atkinson et al. is silent to the balloon catheter's proximal section having an outer tube disposed about the inner tube. Atkinson et al. shows an inflatable balloon with an inner tube with a guidewire lumen. Burns et al. teach a balloon catheter with an outer tube, an inner tube with a guidewire lumen and an inflatable balloon at the distal section in the analogous art of balloon catheters. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the elongate shaft section of the balloon catheter with a proximal section of the balloon catheter with an outer tube to provide an inflation lumen. Further, balloon catheters with an outer tube and inner tube wherein the proximal portion of the balloon is attached to the distal portion of the outer tube and the distal portion of the balloon is attached to the distal portion of the inner tube are well known designs.

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### ***Response to Arguments***

Applicant's arguments with respect to claims 22-25 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

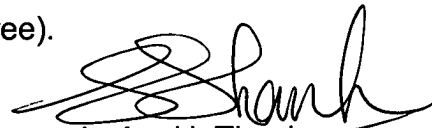
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LoAn H. Thanh whose telephone number is (703) 305-0038. The examiner can normally be reached on Mon. - Fri. (First Friday off).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on (703) 308-3552. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'LoAn H. Thanh', is positioned above the printed name and title.

LoAn H. Thanh  
Primary Examiner  
Art Unit 3763

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